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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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*#6/Response*  
*01/08/03*

In re the Application of )

Vito Savino and James Richard Walton )

) For: APPARATUS AND  
) METHOD FOR SITUATING AN  
) INDUCTIVE ELEMENT IN ASSOCIATION  
) WITH A ROD WITHIN AN ELECTRICAL  
) CIRCUIT

Serial No. 09/596,163 ✓ )

) Examiner: Chang, Rick Kiltae

Filed: June 16, 2000 )

) Group Art Unit: 3729

RESPONSE TO OFFICE ACTION AND ELECTION

Hon. Commissioner of Patents and Trademarks

Washington, D.C. 20231

**RECEIVED**

**JAN 03 2003**

Dear Sir:

**TECHNOLOGY CENTER R3700**

In the Official Action dated December 13, 2002, the Examiner stated that the reply filed on September 30, 2002, is not fully responsive to the Office Action of August 20, 2002. The Examiner set One Month or Thirty Days from the mailing date of the present Office Action, whichever is longer within which to supply omission or correction in order to avoid abandonment.

In the Office Action of August 20, 2002, the Examiner required restriction to one of the following inventions under 35 U.S.C. 121:

- I. Claims 1 – 10, drawn to an apparatus for affixing an inductive element, classified in class 29, subclass 729.

**II. Claims 11-12, drawn to an inductive apparatus, classified in class 336, subclass 174.**

**III. Claim 13 drawn to a method for installing an inductive toroidal element, classified in class 29, subclass 446.**

According to the Examiner, Inventions [I] and [II] are related as subcombinations disclosed as usable together in a single combination. The Examiner opined that the subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, according to the Examiner, invention [I] has separate utility such as the affixing apparatus can be used for other devices. The Examiner referred to MPEP §806.05(d).

Further according to the Examiner, inventions [II] and [III] are related as process and apparatus for its practice. The Examiner opined that the inventions are distinct if it can be shown that with either (1) the process as claimed can be practiced by another materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. The Examiner referred to MPEP §806.05(e). According to the Examiner, in this case the inductive apparatus can be installed using automation process.

The Examiner continued in the Office Action of August 20, 2002, stating that because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

The Examiner continued in the Office Action of August 20, 2002, stating that the application contains claims directed to the following patentable distinct species of the claimed invention:

<b>Embodiment 1:</b>	<b>Figures 1 – 4;</b>
<b>Embodiment 2:</b>	<b>Figure 5;</b>
<b>Embodiment 3:</b>	<b>Figure 6;</b>
<b>Embodiment 4:</b>	<b>Figure 7.</b>

**The Examiner required the Applicant under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. According to the Examiner, currently, none of the claims are generic.**

**The Examiner advised the Applicants that a reply to this restriction requirement must include an identification of the species that is selected consonant with this requirement and a listing of all claims readable thereon, including any claims subsequently added. The Examiner further advised that an argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.**

**The Examiner continued in the Office Action of August 20, 2002, advising that upon allowance of a generic claim, Applicants will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 C.F.R. 1.141. The Examiner stated that if claims are added after the election, Applicants must indicate which are readable upon the elected species, citing MPEP §809.02(a).**

**The Examiner continued in the Office Action of August 20, 2002, stating that should the Applicants traverse on the general ground that the species are not patentable distinct, Applicants should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the Examiner finds one of the inventions patentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.**

**The Examiner continued in the Office Action of August 20, 2002, advising Applicants that the reply to this restriction requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 C.F.R. 1.143).**

**The Examiner reminded the Applicants that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 C.F.R. 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the**

**application. Any amendment of inventorship must be accompanied by a request under 37 C.F.R. 1.48(b) and by the fee required under 37 C.F.R. 1.17(I).**

*Applicants responded in an Election filed September 23, 2002, respectfully traversing the Examiner's restriction requirement. However, in the interest of facilitating examination of the application, Applicants elected to proceed with examination regarding invention I above: Claims 1 – 10 drawn to an apparatus for affixing an inductive element, classified in class 29, subclass 729.*

Here begins Applicants' response to the Office Action of December 13, 2002, to provide a fully responsive reply to the Office Action of August 20, 2002.

Applicants regret any inconvenience to the Examiner in filing a nonresponsive reply to the Office Action of August 20, 2002.

To provide a responsive reply to the Office Action of August 20, 2002, and in response to the Office Action of December 13 2002: Applicants respectfully traverse the Examiner's restriction requirement. However, in the interest of facilitating examination of the application, Applicants elect the species identified by the Examiner as Embodiment 1 (Figures 1 – 4) for prosecution on the merits. Applicants submit that apparatus Claims 1 – 10 are readable on Embodiment 1 (Figures 1 – 4). Applicants further submit that and method Claim 13 should properly remain in the application.

Since Applicants have fully and completely responded to the Official Action, this Application is now in order for early action and such early action is respectfully requested. If the Examiner would deem

a telephone conference to be of value in expediting this Application, he is invited to call the undersigned attorney at (972) 758-1955 at his convenience.

Respectfully submitted,



Donald D. Mondul

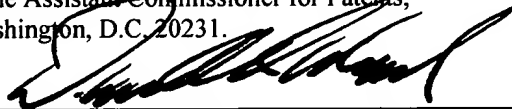
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December 21, 2002 with the U.S. Postal Service as  
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to the Assistant Commissioner for Patents,  
Washington, D.C. 20231.



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Donald D. Mondul, Attorney for Applicants